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Paper No. 7

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JUL 24 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of: Parnell et al.)
Application No. 09/845,785)
Attorney Docket No. 005306.P019)
Filed: April 30, 2001)
For: POLYLINGUAL SIMULTANEOUS)
SHIPPING OF SOFTWARE)

**DECISION ON PETITION TO MAKE
SPECIAL UNDER 37 CFR §1.102(d)**

This is a decision on the petition to make special, filed May 12, 2003 under 37 CFR §1.102(d).

The petition is **DISMISSED**.

For purposes of this decision, the petition to make special is assumed to have been filed in accordance with the "Accelerated Examination" provision of MPEP § 708.02, Section VIII.

MPEP § 708.02, Section VIII, sets out the prerequisites to be met by applicant for a grantable petition for Accelerated Examination under 37 CFR §1.102(d), as follows:

- (A) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);
- (B) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status. The election may be made by applicant at the time of filing the petition for special status. Should applicant fail to include an election with the original papers or petition and the Office determines that a requirement should be made, the established telephone restriction practice will be followed. If otherwise proper, examination on the merits will proceed on claims drawn to the elected invention. If applicant refuses to make an election without traverse, the application will not be further examined at that time. The petition will be denied on the ground that the claims are not directed to a single invention, and the application will await action in its regular turn. Divisional applications directed to the nonelected inventions will not automatically be given special status based on papers filed with the petition in the parent application. Each such application must meet on its own all requirements for the new special status;
- (C) Submits a statement(s) that a pre-examination search was made, listing the

field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;

(D) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and

(E) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

The petition complies with items (A), (C) and (D) mentioned above. However, the petition is deficient with respect to items (B) and (E) above:

(B) The petition states that all the claims are directed to a single invention. Even so, there are several independent claims, each having a different scope, and it will be up to the examiner to make such a determination. Applicant has made no provision for the possibility of a restriction requirement by the examiner. Applicant must provide the following statement as a prerequisite to a grant of special status: "If the Office determines that all claims presented are not obviously directed to a single invention, applicant will make an election without traverse and will follow established telephone restriction practice to make such an election if requested to do so."

(E) Applicant has failed to provide a detailed discussion that points out, *with the particularity required by 37 CFR 1.111(b) and (c)*, how the claimed subject matter is patentable over the references deemed most closely related to the subject matter encompassed by the claims.

Therefore, the Petition is **DISMISSED**. The application file will be forwarded to the Central Files of Technology Center 2100 to await examination in its proper turn based on its effective filing date. Petitioner is entitled to one opportunity to perfect the request in a renewed petition to make special. Any request for reconsideration must be filed within TWO MONTHS of the mailing date of this decision.



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